

REMARKS

Claims 1-23 are pending in this application. Claims 1, 4, 6, 7, 8, 12, 16, and 20-23 are independent claims. Claims 2, 3, 5, 9-11, 13-15, and 17-19 are dependent claims.

Claims 1-23 have been rejected. Amendments to claims 8, 12, 16, and 20-23 are presented herein. Claims 8, 12, 16, and 20-23 have been amended to improve form without changing substance. Claims 24-39 are newly added in this response. No new matter is being presented, and approval and entry are respectfully requested.

The Oath/Declaration

In items 5 and 6 on page 3 of the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. The Examiner indicated that the declaration is defective because (a) it does not state whether the inventor is a sole or joint inventor of the invention claimed, and (b) the nature of the defect(s) in the declaration is that the error set forth as the basis for the reissue application is based on improper recapture. As indicated in item 6 on page 3 of the Office Action mailed July 31, 2001, the rejection of claims 8-22 under 35 U.S.C. § 251 has been withdrawn. Applicants will submit a supplemental declaration upon allowance of the claims having prior art rejections.

Rejections Under 35 U.S.C. § 112, First Paragraph

In item 7 on pages 3 and 4 of the Office Action, the Examiner rejected claims 8, 12, 16, and 20-23 under 35 U.S.C. § 112, first paragraph, as containing new matter. This rejection is traversed for the reasons presented below, and reconsideration is requested.

Applicants note that the Examiner raised the same new matter rejection in the Office Action mailed March 28, 2002. Applicants responded to this rejection in the Amendment filed August 28, 2002, and the Examiner withdrew the new matter rejection in the October 30, 2002 Office Action. For the Examiner's convenience, the arguments presented in the August 28, 2002 Amendment are presented below.

The Examiner asserted on page 4 of the Office Action that the one-way connection feature of independent claims 8, 12, 16, and 20-[23] is not disclosed in the specification or drawings. However, two-way (bi-directional) switch connections are not disclosed in the present application.

The specification does not mention data flowing in two directions along a particular switched connection. The specification only mentions data flowing from communications 51 toward the user for presentation to the user, from the medium 52 toward the user, or from the communications 51 to the medium 52. For example, page 4, lines 1-4 of the specification state that the "present invention provides an input switchover means for switching input routes according to the type of data offering format ... provided to the user" (emphasis added). At no time does the specification refer to, for example, the user sending data to the communications 51 using the established switched connection. In fact, one of the purposes of the present invention is to provide a system for distributing copyrighted computer applications to users.

Therefore, Applicants submit that claims 8-23 meet the requirements of 35 U.S.C. §112. Accordingly, Applicants respectfully request withdrawal of the rejection to the claims under §112, first paragraph.

Applicants respectfully request that the finality of the current Office Action be withdrawn because this issue was previously resolved and because the arguments presented in the March 26, 2003 Amendment have not been addressed.

Rejections Under 35 U.S.C. § 112, Second Paragraph

In item 8 on page 4 of the Office Action, the Examiner rejected claims 8, 12, 16, and 20-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth therein. Applicants submit that amendments to the claims presented above meet the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request withdrawal of the rejections to the claims under § 112, second paragraph.

Rejections Under 35 U.S.C. §§ 102 and 103

In item 10 on pages 5-9 of the Office Action, the Examiner rejected claims 8-10, 12-14, 16-18 and 20-22 under 35 U.S.C. §102(b) as being anticipated by Shear (U.S. Patent No. 5,410,598). Also, in item 11 on pages 10 and 11 of the Office Action, the Examiner rejected dependent claims 11, 15, and 19 under 35 U.S.C. §103(a) as being unpatentable over Shear in view of Allen (U.S. Patent No. 5,418,713). Applicants respectfully traverse these rejections for the reasons presented below.

In item 9 on page 4 of the Office Action, the Examiner indicated that the addition of the one-way connection is seen to be new matter and, therefore, the previous prior art rejections stand. In view of the above discussion regarding new matter, Applicants maintain their arguments with respect to claims 8-23 as found in the previous Response filed March 26, 2003.

Therefore, Applicants submit that claims 8-23 patentably distinguish over the prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under §§ 102 and 103.

New Claims

Claims 24-39 are newly added with this response to alternatively define the present invention. Independent claim 24 recites “a communication medium providing external digital information in one direction; digital information receiving means for receiving digital information provided via the communication medium; ... switch means for switching a connection between one of said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means ...” Independent claim 28 recites similar language.

Independent claim 32 recites “a communication path providing external digital data in one direction; ... a switch having a first switch position which connects digital data provided by the communication path to the converter, ... a second switch position which connects digital data read from the storage medium to the converter, ... and a third switch position which connects digital data provided by the communication path to the storage medium ...”

Independent claim 36 recites “a communication path providing external digital data in one direction; ... a switch having a first switch configuration which, when non-encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter without passing through the decoder, ... a second switch configuration which, when encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter and the decoder, ... a third switch configuration which, when non-encrypted digital data is read from the storage medium, connects the digital data read from the storage medium to the converter without passing through the decoder, ... a fourth switch configuration which, when encrypted digital data is read from the storage medium, connects the digital data read from the storage medium to the converter and the decoder, ... and a fifth switch configuration which connects the digital data provided by the communication path to the storage medium ... ”

Independent claim 37 recites “a first switch position which connects external digital data provided by a communication path in one direction to a converter ...; a second switch position which connects digital data read from a storage medium to the converter, ... and a third switch position which connects the digital data provided by the communication path to the storage medium, ... ”

Independent claim 38 recites “first means for connecting external digital data provided by a communication path in one direction to a converter ...; second means for connecting digital data read from a storage medium to the converter, ...; third means for connecting the digital data provided by the communication path to the storage medium, ... ”

Independent claim 39 recites “a communication medium providing external digital information in one direction; digital information receiving means for receiving digital information provided via the communication medium; ... switch means for switching a connection between one of said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means; selecting means for selecting one of said digital information received by said digital information receiving means and said digital information read by said drive means and inputting the selected digital information to said information converting means to obtain at least one of visible and audible data based on the selected digital information, which is received from different types of digital information sources ...”

It is the position of the applicants that these features are not taught or suggested by the cited references. Thus, it is submitted that claims 24-39 patentably distinguish over the prior art. Accordingly, the applicants respectfully request allowance of the new claims.

Claims 25-27, 29-31, and 33-35 are dependent claims that should be allowable for the reasons described above.

Request for Return of Form PTO-1449

On January 28, 2003, Applicants filed an Information Disclosure Statement (IDS) with a Form PTO-1449. A copy of this form was returned to the applicant with the May 16, 2003 Office Action. However, the Seki et al. reference (reference AM) had been marked through and not initialed. Accordingly, it is requested that the Examiner confirm consideration of this reference by initialing the block next to reference AM and returning the 1449 form. For the Examiner's convenience, copies of the IDS, the 1449 form, the Seki et al. reference (which includes the English language translation of the abstract), and the stamped postcard are attached to this response.

Conclusion

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/654,929

Docket No. 1046.1100RE

Finally, if there are any additional fees associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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